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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,164	07/06/2001	Ludwig M. Auer	LZ-48PCT	2745

7590 02/18/2004  
Friedrich Kueffner  
317 Madison Avenue, Suite 901  
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EXAMINER

ROBINSON, DANIEL LEON

ART UNIT PAPER NUMBER

3742

DATE MAILED: 02/18/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/807,164

Applicant(s)

AUER, LUDWIG M.

Examiner

Daniel I. Robinson

Art Unit

3742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Specification***

The abstract of the disclosure is objected to because the phrase “the invention concerns” should be deleted. Correction is required. See MPEP § 608.01(b).

***Drawings***

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9-11, and 13-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schneider (WO 98/38908). Schneider discloses an imaging device and method that shows all the features of the claimed invention including two modalities to obtain two images of a patient and to update and record the images by comparing images from the two modalities (abstract, Figs. 1-4). The images, generated by computerized x-ray tomography, magnetic resonance imaging, electric potential tomography or any other conventional means, can be rotated, translated and scaled to match the other image.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider in view of Funda et al.(U.S.Pat.6,201,984). Schneider does not explicitly show a surgical robot that can be manually instructed. Funda discloses a system and method for augmentation of endoscopic surgery that shows a surgical robot with manual inputs(abstract, Figs.1-4). It would have been obvious to one of ordinary skill at the time of the claimed invention to use a surgical robot with manual inputs because the robot can work under automatic control and the manual inputs allow for individual control over separate arms of the robot.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider in view of Funda as applied to claim 4, and further in view of Glassman et al.(U.S.Pat.5,408,409). Schneider in view of Funda does not explicitly show predetermined work area. Glassman discloses an image-directed robotic system for precise robotic surgery that shows a predetermined work area(Figs.1-3b). It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to use a predetermined work area as taught by Glassman with the invention of Schneider in view of Funda because a surgical instrument can not disturb adjacent tissue.

Claims 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider in view of Funda as applied to claims 1-3, 9-11 and 13-17 above, and further in view of VomLehn et al.(U.S.Pat.5,978,969). Schneider in view of Funda does not explicitly show an ultrasound imaging apparatus. VomLehn disclose a real time image-guided placement of anchors that shows an ultrasound imaging device as part of a surgical apparatus(col. 3). It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to use ultrasound as part of Schneider in view of Funda because the ultrasound imaging device can provide a non-invasive image of an internal organ or body part.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Grimson, Glassman'288, Glassman'401, Schneider'227, Badano, and Peshkin are cited to show structure and methods similar to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Robinson whose telephone number is 703 306-9043. The examiner can normally be reached on M-F 5:30am-2:30pm.

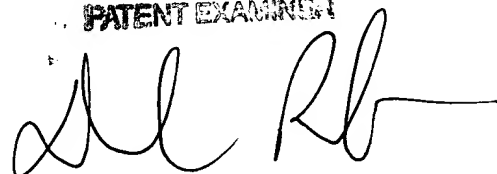
The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dlr

DANIEL ROBINSON  
PATENT EXAMINER

A handwritten signature in black ink, appearing to read 'DLR' followed by a stylized 'R' and a horizontal line.